



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/681,076      | 10/07/2003  | Daniel Resnic        |                     | 7675             |

33873 7590 01/11/2006

ERIC HANSCOM  
7395 PORTAGE WAY  
CARLSBAD, CA 92011

EXAMINER

ALI, SHUMAYA B

ART UNIT PAPER NUMBER

3743

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

TAK

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/681,076             | RESNIC, DANIEL      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Shumaya B. Ali         | 3743                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/7/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 13-16, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 17, 18 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> .                  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. **Claims 1-12,17,18, drawn to a condom, classified in class 128, subclass 844.**
  - II. **Claims 13-14, drawn to a method of providing direct penile stimulation, classified in class 128, subclass 844.**
  - III. **Claim 15, drawn to holding the condom within the orifice of the passive user during coitus, classified in class 128, subclass 844.**
  - IV. **Claims 16, 19-20, drawn to manufacturing a thickened tubular condom, classified in class 128, subclass 844.**

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II-IV and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case both (1) and (2) apply.
3. During a telephone conversation with **Eric Hanson on 1-3-2006** a provisional election was made **without traverse** to prosecute the invention of **Group I, claims 1-12, 17, and 18**. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 13-16, 19-20 are withdrawn** from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3743

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 recites the limitation **"the interior and the exterior"** in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation **"said strap"** in line 18. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1,2,8, 11, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Alla et al. US Patent No. 5,992,415**

**As to claim 1, Alla et al. disclose a condom (see abstract and figures 1-4)**

**As to claim 2, Alla et al. discloses a condom (see abstract and figures 1-4) with a semi-rigid, soft, pliant, stretchable wall material (17, col.4 lines 20-26) defining an open proximal end (16) and a closed distal end (14), having a generally phallic shape (see fig.1); said sheath being adapted to receive a male sex organ via the open proximal end and additionally being adapted to be inserted into a sexual orifice of a passive partner such as a vagina and an anus (applicant is reminded that the functional language do not hold patentable weight in the apparatus claims), and wherein said condom of the type**

Art Unit: 3743

comprising an elastomeric material of the type comprising a super stretchable, non burstable, semi-rigid material selected from a group consisting of polymers, USP class six thermoplastic elastomer (TPE), silicone rubber, latex or other semi rigid, soft, pliant, stretchable, biocompatible material or combination and derivatives thereof (**col.4 liners 20-26**); wherein said elastomeric material surrounds the penis completely enclosed, said sheath having a sufficiently large diameter (**fig.1**), wherein movement of the penis is made possible within the condom during coitus, whereby fluid communication is prevented between the interior and the exterior thereof (**applicant is reminded that the functional language do not hold patentable weight in the apparatus claims**)

**As to claim 8, Alla et al. disclose** the condom of claim 2, wherein a reservoir or reservoirs (**28**) are disposed in a substantially closed compartment or compartments inside the closed distal end of the condom, wherein said reservoir or reservoirs optionally include a foam, or otherwise sponge-like, disk insert, whereby said inside will absorb transmission of bodily fluids propelled in a distal direction and prevent backflow and spillage thereof (**col.2 lines 64-67**).

**As to claim 11, Alla et al. disclose** the condom of claim 2, wherein an assembly for delivering and piloting the condom into the sexual organ of a passive participant comprising:

(a) Said safety condom wherein the proximal open end (**16**)\_ is adapted for receiving an insertion applicator, and (b) said insertion applicator of the type comprising a biocompatible, rigid, shape-retaining plastic or polymer form (**28**), the applicator having a length greater than the length of the condom, the insertion applicator being in co-axial communication with the tubular sheath (**fig.4**), whereby easy insertion is made possible for the passive user.

(a) the condom adapted to be inserted into a sexual orifice of passive participant such as the vagina or the anus via the closed distal end, whereby the condom may function as an internal female or passive-user

Art Unit: 3743

device **(applicant is reminded that the functional language do not hold patentable weight in the apparatus claims)**

**As to claim 17, Alla et al. disclose** the universal, unisex condom of claim 2, wherein the collar at the open proximal end **(fig.1)**, of the type comprising an expanding of the condom to its largest diameter in order to maintain the collar outside the vagina or anus during sexual intercourse, the tubular sheath portion being of a size to form a loose fit around the penis **(applicant is reminded that the functional language do not hold patentable weight in the apparatus claims)**, wherein the wall of the tubular portion is formed with said flexible, semi-rigid material, whereby the wall facilitates insertion into the sexual orifice of the passive user **(col.4 lines 20-26)**.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 4-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Alla et al. US Patent No. 5,992,415 in view of Hegedusch US Patent No. 5,121,755**

**Alla et al. do not disclose** "a first mean" and as to claims 5, 7 **Alla et al. do not disclose said** retaining strap of the type comprising a stretchable material. However at the time of the invention the second means as a strap was well known in the art". **However at the time the invention was made the "first mean" as claimed by the applicant as a strap mean was well known in the art. This limitation**

Art Unit: 3743

is taught by Hegedusch US Patent No. 5,121,755, see fig.4, 100. Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the condom of Alla et al. in view of Hegedusch in order to provide a strap as a first mean for the purposes of securely fastening the condom (sheath) to the male genitalia as taught by Hegedusch, see col.2 lines 22-26.

8. Claim3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alla et al. US Patent No. 5,992,415 as applied to claim 1 above, and further in view of Schwartz US Patent No. 5,513,652.

As to claim 3, Alla et al. teaches all claimed limitation except for a tapered, narrow, neck, however this limitation was known at the time of the invention. Schwartz teaches a condom with a tapered, narrow neck in fig. 4, 22. Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the condom of Alla et al. in view of Hegedusch in order to provide a tapered, narrow proximal end for the purposes assisting erectile function as taught by Schwartz, see col.5 lines 1-10.

9. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alla et al. US Patent No. 5,992,415 and Hegedusch US Patent No. 5,121,755 as applied to claim 4 above, and further in view of Schwartz US Patent No. 5,513,652

As to claims 6 and 18, Alla et al. teaches all claimed limitation except for a tapered, narrow, neck, however this limitation was known at the time of the invention. Schwartz teaches a condom with a tapered, narrow neck in fig. 4, 22. Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the condom of Alla et al. in view of Hegedusch in order to provide a tapered, narrow proximal end for the purposes assisting erectile function as taught by Schwartz, see col.5 lines 1-10.

***Claim Objections***

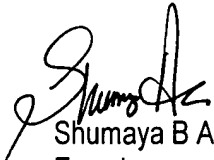
10. Claim 4 is objected to because of the following informalities: consider revising claim language, recitation seem to be vague therefore the metes and bounds of the limitation seems to be unclear.

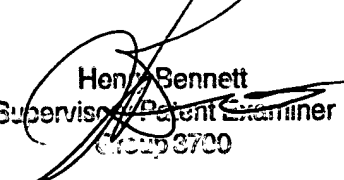
Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shumaya B Ali  
Examiner  
Art Unit 3743  
1/9/06

  
Henry Bennett  
Supervisor Patent Examiner  
Group 3700